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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/922,549 | 08/03/2001 | Jeffrey C. Rapp | AVI 013N | 1388 |
| 26739 | 7590 | 11/22/2005 | EXAMINER | |
| AVIGENICS, INC. 111 RIVERBEND ROAD ATHENS, GA 30605 | | | MCGILLEM, LAURA L | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1636 | |

DATE MAILED: 11/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/922,549

Applicant(s)

RAPP, JEFFREY C.

Examiner

Laura McGillem

Art Unit

1636

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 25 October 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: 88-96, 121-134 and 148-155.
Claim(s) objected to: _____.
Claim(s) rejected: 70, 72-82, 102, 104, 105, 107-115, 135, 136, 138, 139, 141-147 and 156-174.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s).
13. ☐ Other: See Continuation Sheet.


DAVID GUZO
PRIMARY EXAMINER

Continuation of 3. NOTE: Applicant's amendments to the claims raise further issues for consideration that would require a search of prior art. For example, claim 174 recites "a nucleotide sequence of SEQ ID NO:67" which reads on any fragment of SEQ ID NO:67 without functional limitations, and most likely would be obviated by prior art. Further, the scope of claims 176, 179 and 181, for example, was altered from "a protein of pharmaceutical interest" to "a heterologous polypeptide", which broadens the scope of the invention and would require additional consideration. Claim 193 recites that the isolated DNA molecule of claim 192 is integrated into a cellular genome, a limitation not present for "an isolated DNA molecule" in the previous corresponding claim, which would broaden the scope of the claim and which may constitute impermissible new matter. Claim 204 recites an expression vector comprising a nucleic acid coding for heterologous protein of pharmaceutical interest, which was not present in the previous claim set and therefore broadens the scope of the claims and potentially adds new matter. Claim 216 recites a cell comprising a nucleic acid coding for a heterologous protein of pharmaceutical interest, which was not present in the previous claim set and therefore broadens the scope of the claims and potentially adds new matter.

Continuation of 11. does NOT place the application in condition for allowance because: Once a final rejection that is not premature has been entered in an application, applicant or patent owner no longer has any right to unrestricted further prosecution. The amendments do not place the application either in condition for allowance or in better form for appeal. For reasons given above, and on the grounds that the amended claims potentially include new matter and raise further issues for consideration which would require an additional search of the prior art, the amended claims have not been entered. The amendments do not place the application either in condition for allowance or in better form for appeal. Therefore, Applicant's arguments based on addition of the amended claim set are moot. Applicant is invited to review MPEP 714.12..